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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,728	10/19/2001	Yukari Hashizume	550718-093	7391

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,728

Applicant(s)

HASHIZUME, YUKARI

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Continued Prosecution Application

1. The request filed on June 23, 2003 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/037,728 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1 has been amended for further examination.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmeister (5,301,445) in view of Ashcraft et al (6,045,161).

Hoffmeister discloses in Fig. 1, a binder insert comprising: a transparent plastic bag shaped body (24) with an open upper side (34); a photograph store portion (20) and a memo store portion (22); a store board (12); and wherein a memo paper can be inserted in the memo portion (Col. 1, lines 55-60); and a binding section (18) having holes.

However, Hoffmeister does not disclose: a store board comprising thick paper folded in two and having slits at a predetermined location; a color paper disposed between facing surfaces of the thick paper; and slits in various shapes.

Ashcraft et al discloses in Fig. 1-3, a store board (36) comprising thick paper folded in two (42 and 46) having a set of slits (44, slits which form the tabs) at a predetermined location; a color paper (34) disposed between the thick paper surfaces.

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hoffmeister's binder insert to include a store board comprising folded thick paper having slits, and a inserted color paper as taught by Ashcraft et al for the purpose of mounting the photographs in a stable position on the store board.

In regards to **Claim 1**, it is understood that the process of making a store board can be made by a myriad of processes and that patentability is based solely on the product (see MPEP 2113, *In re Morosi and Exparte Gray*). Therefore, dividing the portions can be done by any desirable method.

In regards to **Claims 3 and 11**, the slits being used to insert corner of a photograph and a color paper therebetween, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the slits are capable of being used to hold a photograph and a color paper therebetween.

In regards to **Claims 4, 5, 7-10, and 13-16**, it would have been an obvious matter of design choice to make the different portions of the slits of whatever form or shape was desired or

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expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claims 10 and 16**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the slits at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claims 6 and 12**, matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Therefore, any desirable colored paper can be inserted in the slots.

Response to Arguments

4. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

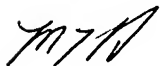
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Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Matteau et al, Ashcraft et al ('443), Townsend et al, Mirza, Bradley et al, Williams, JP-655889, JP-21498, Parobek, and Ruebens disclose similar inserts.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 31, 2003


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
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